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PATENT

S/N 08/953,154

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Keith A. Kozak et al.	Examiner:	Anatoly Vortman
Serial No.:	08/953,154	Group Art Unit:	2835
Filed:	October 17, 1997	Docket:	450.154US1
Title:	MODULAR COMPUTER DEVICE AND COMPUTER KEYBOARD FOR MODULAR DEVICE		

RESPONSE TO RESTRICTION REQUIREMENT AND INTERVIEW SUMMARY

Commissioner for Patents
Washington, D.C. 20231

Applicant has carefully reviewed and considered the Restriction Requirement mailed June 13, 2001, and the Examiner's Interview Summary mailed July 16, 2001. Applicant's attorney thanks Examiner Vortman for the interview by telephone on July 12, 2001, and the Examiner's voice mail message of July 13, 2001. As noted in the Examiner's Interview Summary, no agreement was reached with respect to the claims and the propriety of the Restriction Requirement.

In response to the Restriction Requirement, Applicant elects with traverse the claims of Group I (claims 1-11, 13-18, 20, and 21). The Restriction Requirement is traversed on two grounds. First, Applicant submits that a Restriction at this stage of prosecution is improper. On June 6, 2000, Applicant filed a Notice of Appeal of the final rejection of the pending claims in the final Office Action mailed February 24, 2000. Applicant then timely filed an appeal brief on January 29, 2001. The MPEP is quite clear on how prosecution is advanced during the appeal process. Specifically, MPEP 1208 provides that the Examiner may file an answer to Applicant's appeal brief. Furthermore, MPEP 1208 further states:

"if a new ground of rejection is necessary, prosecution must be reopened. The examiner must obtain approval from the Supervisory Patent Examiner prior to reopening prosecution after an appeal."

Rather than provide a new grounds of rejection, and contrary to MPEP 1208, Examiner Patel issued an Office Action withdrawing the final rejection in the Office Action mailed

February 24, 2000, and further issued a restriction requirement. Applicant respectfully submits that both the withdrawal of the final rejection and the Restriction Requirement are improper.

MPEP 706.07(e) controls withdrawal of final rejections, and provides in pertinent part:

The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the examiner that the previously rejected claims are in fact allowable or patentable in the case of reexamination, then the final rejection should be withdrawn. Occasionally, the finality of a rejection may be withdrawn in order to apply a new ground of rejection.

Thus, as is clear from the above language, a final rejection may be withdrawn to either allow previously rejected claims, or to provide a new grounds of rejection. No provision is made for withdrawing a final rejection in order to issue a restriction requirement, as was done in this case.

Furthermore, issuing a restriction requirement at this stage of prosecution is improper. The requirements for restriction are provided in 37 C.F.R § 1.142 which provides in pertinent part:

If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

In this case, a restriction requirement was not issued until after four separate Office Actions, including two final actions. Clearly this is contrary to the requirements of 37 C.F.R. § 1.142.

Finally, Applicant notes that Applicant is entitled to appeal the rejection of the claims regardless of the fact that the final rejection was withdrawn. Each of the claims have been twice rejected before. It is unfair to subject the Applicant to the further time and expense of preparing three new appeal briefs corresponding to the three claim groupings should the restriction requirement be maintained. Furthermore, the burden on the Examiner and the Board are increased should the Applicant be forced to pursue three separate appeals.

For all of the above reasons, the withdrawal of the final Office Action and the Restriction Requirement are improper. Applicant respectfully requests that the Restriction Requirement be withdrawn and that the Appeal be reinstated per MPEP 1208.02. Because no new grounds of

rejection have been provided, Applicant believes that filing a supplemental Appeal Brief is not necessary until a proper response to Applicant's appeal is received.

Even if a Restriction Requirement is proper (which Applicant does not admit), the Requirement is traversed on the basis that a search and examination of all the claims can be made without serious burden. If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it arguably may include claims to distinct or independent inventions. M.P.E.P. § 803 (emphasis added). The two groups of claims are related in that they both describe systems and devices providing key input to a computer system and both groups involve dockable devices. Thus, the searches for both will be similar. Due to the relatedness of the subject matter of the claims of groups I, II and III, Applicant submits that the search and examination of both groups of claims can be made without serious burden.

Further evidence that the search and examination of the claims can be made without serious burden is the fact that the claims have already been searched and examined on the merits at least once and have been the subject of four Office Actions.

For the above reasons, reconsideration and withdrawal of the Restriction Requirement is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

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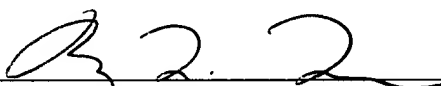
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Respectfully submitted,

KEITH A. KOZAK ET AL.

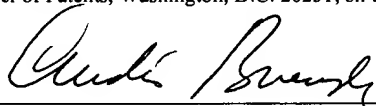
By their Representatives,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 15th day of October, 2001.

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